

REMARKS

Status Of Application

Claims 1-13 are pending in the application, of which claims 5-12 have been withdrawn from consideration.

In the Office Action it is noted that:

Claim 13 is objected to;

Claim 2 is rejected under 35 U.S.C. § 112;

Claims 1, 3 and 4 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,035,145 to Kanai ("Kanai");

Claim 2 is rejected under 35 U.S.C. § 103(a) over Kanai in view of U.S. Patent No. 5,028,125 to Kikuchi ("Kikuchi"); and

Claims 13 is rejected under 35 U.S.C. § 103(a) over Kanai in view of U.S. Patent No. 5,627,618 to Kasai et al. ("Kasai").

Claim Amendments

Claims 1 and 13 have been amended to more particularly point out and distinctly claim the invention.

Rejection under 35 U.S.C. § 112

The rejection of claim 2 under the second paragraph of 35 U.S.C. § 112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, is respectfully traversed based on the following.

As a basis for the present rejection, the Office Action points out that claim 2 recites that the third lens unit is kept stationary, while claim 1 recites a lateral magnification at both a wide-angle end and a telephoto end for the third lens unit, alleging that it is unclear how a stationary lens can have a wide-angle end or a telephoto end.

In response, it is respectfully pointed out that claim 1 simply defines an objective optical system, which includes the third lens unit that may or may not be later positioned in one or the other of the wide-angle and telephoto ends. But what may or may not happen in the future is not part of the claimed invention. The claimed invention does include present limitations on each part, such as what the particular lateral magnifications of the third lens unit would be at each of the wide-angle and telephoto ends. In other words, the third lens is so structured that it imparts the claimed magnifications if so positioned. However, such positioning is not required by claim 1. Claim 1 even explicitly includes the situation where only one lens moves by reciting “wherein, as zooming is performed...**at least one** of the second and third lens units is moved...” (emphasis added). Claim 2 is then directed towards the more specific situation wherein “the second lens unit is moved and the third lens unit is kept stationary.” Therefore, one skilled in the art would have no difficulty determining whether a particular collection of parts infringed the collection of interrelated elements defined by these claims.

Accordingly, it is respectfully requested that the rejection of claim 2 under the second paragraph of 35 U.S.C. § 112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 103(a)

Claims 1, 3, and 4

The rejection of claims 1, 3, and 4 under 35 U.S.C. § 103(a) over Kanai is respectfully traversed based on the following.

Kanai relates to a real-image variable magnification view finder aimed at reducing the number of lens elements while obtaining a zoom ration higher than 3. Kanai teaches achieving this with embodiments that include an objective optical system 10 having four lens groups 11-14 having positive power, negative power, positive power, and negative power, respectively. Kanai teaches that the prior art is improved upon by providing the

objective optical system 10 with a fourth lens group, designated therein fourth lens group 14. Specifically, Kanai teaches that the addition of a fourth lens group 14 provides for a higher zoom ratio, and that the fourth lens is critical to reducing the physical size of the objective optical lens system as compared to prior objective optical systems having only three lens groups.¹

It is respectfully submitted that claims 1, 3, and 4 are not obvious in view of Kanai.

With respect to independent claim 1, it is respectfully submitted that the subject matter claimed therein patentably distinguishes over Kanai. Specifically, claim 1, as amended, recites:

an objective optical system, having a positive optical power, for forming a real image in an optical path;
an eyepiece optical system, having a positive optical power, for transmitting the real image formed by the objective optical system to a pupil of an observer; and
an erecting optical system, disposed in the optical path, for inverting the real image formed by the objective optical system,
wherein **the objective optical system consists of three lens units**....(emphasis added).

Thus, claim 1 includes an objective optical system closed to the inclusion of lens units other than the three lens units recited in the claim. This results in an objective optical system in claim 1 having a unique arrangement compared to that disclosed by Kanai, since, for example, the Kanai objective optical system has a positive-negative-positive-negative construction, while the objective optical system of claim 1 has a positive-negative-positive construction. In addition, as discussed above, Kanai teaches away from an objective optical system with fewer than four lens groups. Indeed, the teaching of Kanai makes the invention of claim 1 seem unachievable by teaching that the fourth lens group is a critical component. As pointed out in the MPEP, “the omission of an element and retention of its function is an indicia of unobviousness.”² Claim 1 sets forth an objective optical system that omits the fourth lens group of the Kanai objective optical

¹See Kanai, col. 3, line 46- col. 4, line 10.

² MPEP 2144.04(II)(B) (8th ed., August 2001).

system while retaining the zooming functionality. Thus, for these reasons, it is respectfully submitted that claim 1 patentably distinguishes over Kanai.

With respect to claims 3 and 4, these claims depend from independent claim 1, and therefore incorporate all of the limitations of claim 1. Thus, it is respectfully submitted that claims 3 and 4 patentably distinguish over Kanai for the reasons discussed in connection with claim 1.

Accordingly, it is respectfully requested that the rejection of claims 1, 3, and 4 under 35 U.S.C. § 103(a) over Kanai be reconsidered and withdrawn.

Claim 2

The rejection of claim 2 under 35 U.S.C. § 103(a) over Kanai in view of Kikuchi is respectfully traversed based on the following.

Kikuchi discloses a zoom finder optical system comprising first to third lens groups 1-3, and an eyepiece 4. Kikuchi discloses that a zooming operation can be performed by moving the second lens group 2 between the first and third lens groups 1 and 3. Kanai, on the other hand, discloses a real-image variable magnification view finder that includes an objective optical system 10 having four lens groups 11-14. Kanai provides two embodiments, and in both embodiments zooming is achieved by moving two lens groups. In both of the Kanai embodiments, the second lens group is moved rearwardly and the third lens group is moved forwardly. Thus, Kikuchi and Kanai are directed to respective optical systems having differing constructions and principles of operation.

The present Office Action alleges that “it would have been obvious ...to move only the second lens group of Kanai as taught by Kikuchi as an alternative means for performing a zooming operation.”³ However, the Office Action fails to point to any motivation for one skilled in the art to combine Kanai and Kikuchi. As set forth in the

MPEP, establishing a *prima facie* case of obviousness requires *inter alia* that “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.”⁴ Therefore, absent any motivation for combining Kanai and Kikuchi, it is respectfully submitted that claim 2 patentably distinguishes Kanai in view of Kikuchi.

The MPEP also sets forth that “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”⁵ As pointed out above, the optical systems set forth in Kanai and Kikuchi are not the same in construction or in operation. Yet, the present Office Action has provided no evidence to suggest that the Kanai system can be modified to operate like the Kikuchi system without rendering the Kanai system “unsatisfactory for its intended purpose.” That is, the present Office Action points to no teaching in the prior art or knowledge available to one skilled in the art at the time of the invention to suggest that the Kanai system would function properly, according to its intended purpose, if the proposed modification were to be made.

Along the same lines, the MPEP further sets forth that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”⁶ Modifying the Kanai optical system, wherein two lens groups are moved for zooming, to operate like the Kikuchi optical system, wherein one lens group is moved for zooming, would “change the principle of operation” of the Kanai optical system. Therefore, since the proposed modification in the Office Action would change the principle of operation of the Kanai optical system, the teachings of Kanai and Kikuchi are not sufficient to render claim 2 *prima facie* obvious.

³ Office Action, page 7, lines 7-9.

⁴ MPEP 2143 (8th ed., August 2001).

⁵ *Id.*

⁶ *Id.*

Accordingly, it is respectfully requested that the rejection of claim 2 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Claim 13

The rejection of claim 13 under 35 U.S.C. § 103(a) over Kanai in view of Kasai is respectfully traversed based on the following.

It is respectfully submitted that claim 13, as amended, recites similar features as amended claim 1, specifically that “the objective optical system consists of three lens units,” and therefore patentably distinguishes over Kanai for the reasons discussed in connection with claim 1. It is noted, however, that the rejection of claim 13 is based on Kanai in view of Kasai. Kasai is relied upon for teaching “to move the first lens unit...for adjusting dioptric power.”⁷ Even if, for the sake of argument, this allegation were true, and even if, for the sake of argument, Kasai were properly combinable with Kanai, Kasai would still fail to provide for the deficiencies of Kanai with respect to the present rejection. That is, each of the first to fifth embodiments disclosed in Kasai include a respective objective optical system having four lens groups G1-G4 having positive-negative-negative-negative powers, respectively. So combining Kanai and Kasai would provide no suggestion of “the objective optical system consists of three lens units” recited in claim 13. Therefore, it is respectfully submitted that claim 13 patentably distinguishes over Kanai in view of Kasai.

Accordingly, it is respectfully requested that the rejection of claim 13 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. §1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any fee required for such Petition for Extension of Time, and any other fee required by this document, other than the issue fee, and not submitted herewith, should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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⁷ Office Action, page 8, lines 12-13 (October 17, 2002).